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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/112,020	07/08/98	AOKI	K 1945-104R

WM51/1102

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EXAMINER

URBAN, E

ART UNIT

PAPER NUMBER

2683

11

DATE MAILED:

11/02/00

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/112,020
Filing Date: 7/8/98
Appellant(s): Aoki et al.

Vincent M. DeLuca
For Appellant

EXAMINER'S ANSWER

Mailed
NOV 02 2000
Technology Center 2600

This is in response to appellant's brief on appeal filed 8/8/00.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it fails to describe the mobile communication terminal equipment being contained within a vehicle, such as an automobile, as numerously pointed out in the Abstract, Summary of the Invention and the Detailed Description of the Preferred Embodiments in Patent 5,535,430. It is believed that this feature is needed in order to properly summarize the invention. Further discussion on this topic will be found in the 112, first paragraph rejection and Response to Arguments.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

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The rejection of claims 19-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,303,286	Wiedeman	4-1994
4,123,534	Japanese document	4-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The above claims, as they are currently amended, recite a mobile communication terminal containing a satellite transceiver and a portable set disconnectable to the satellite transceiver and having a terrestrial transceiver. However, throughout the disclosure, the mobile communication terminal equipment has been defined as being mounted in a vehicle, such as an automobile and the inventive concepts of such have been directed to a mobile communication terminal equipment mounted in a vehicle. These claims, as now recited, encompass a mobile communication terminal that may be entirely portable; that is, a mobile communication terminal in which the satellite transceiver is portable. Such a feature is not supported by the original patent disclosure and therefore was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiedeman in view of Japanese document no. 4123534.

As to claims 19 and 23, Wiedeman discloses a mobile communication terminal equipment 501 containing a satellite transceiver 520 including a satellite transmission/reception circuit for communicating with a satellite system, a terrestrial transmission/reception circuit 503 for communicating with a terrestrial system, a signal input/output for inputting and outputting signals to/from the user and a connection controller and switching means 530,531 for selectively

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connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transceiver. Wiedeman does not disclose a portable set disconnectable from the satellite transceiver. However, the above Japanese document discloses a portable set 100,140,154 for communicating to a local area, terrestrial system when disconnected from a different transceiver, or mover, 102 for communicating to another system such as a satellite system but can communicate and connect with either of the local networks when connected with the mover 102. Therefore, it would have been obvious to one having ordinary skill in the art to apply this portable unit communication technique of the above Japanese document to the system of Wiedeman for the purpose of allowing the phone to be more compact when only communicating with a particular local system. As to the other local area network being able to communicate with a satellite system, such would have been obvious to one of ordinary skill in the art since one would want to communicate at a much farther distance. It is considered that the above modified system contains satellite and terrestrial control means (contained in microprocessor CONT) for controlling signal transmission and reception unit as recited in claims 20 and 24 and command input means for inputting a user's command relating to the operation of the switching means as recited in claims 201-22 and 25-26. It is also considered that particular control signals are transmitted between the satellite and terrestrial control means and command input means in order for the device to properly operate and switch to the appropriate communication system.

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Allowable Subject Matter

Claims 1-18 are allowed.

(11) *Response to Argument*

Appellant makes four arguments with respect to the 35 U.S.C. 112, first paragraph rejection. Appellant firstly argues that the claims “do not require that the satellite transceiver be portable, but to the contrary simply do not require the satellite transceiver to be mountable in a vehicle”. This statement is incorrect. The written description requirement determines whether those skilled in the art would have recognized from the original specification whether the applicant was in possession of the later claimed invention. Although the claims do not specifically recite that the satellite transceiver be portable, the claims do encompass such an embodiment. Given the fact that all the embodiments contained within the specification involve the use of a vehicle (as evidenced by the description as well as all the drawings) to transport the satellite transceiver, and given the fact that there is no suggestion within the specification to make the satellite transceiver portable, then one of ordinary skill in the art could not have recognized from the original specification to make the satellite transceiver portable.

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Appellant secondly argues that “the specification does not describe a satellite transceiver mounted in a vehicle as asserted in the Office action, but ^{rather} ~~rather~~ describes a satellite transceiver that is mountable in a vehicle”. Again, the specification clearly describes the use of the satellite transceiver within a vehicle and also numerous uses the term “mounted” to describe the placement of the satellite transceiver. Appellant argues that in col. 12, paragraph 8 that there is only a suggestion to mount the satellite transceiver within a vehicle. However, the complete phrase (“the transceiver unit 3 may be disposed within the interior of the vehicle M, for example, the trunk of an automobile”) merely describes that the transceiver unit may be placed in a specific location within the interior of the vehicle, such as a trunk.

Appellant thirdly argues that the third aspect of the invention as disclosed in column 4 is not dependent upon being mounted in a vehicle. This statement is incorrect. Col. 4, lines 27-28, states that this embodiment is “mounted in a vehicle”. Note also in col. 5, lines 49-54 that the third embodiment is described as only the portable set is located remote from the vehicle when detached from the satellite transceiver. Col. 5, lines 41-45 also states that the third embodiment is constructed according to the second embodiment which also describes only the portable set being located remote from the vehicle when detached from the satellite transceiver (col. 4, lines 4-8).

Appellant fourthly argues that “one of the stated objectives of the invention is to reduce the size of the satellite transceiver”. Here, it is important to note how the specification describes “the size” of the satellite transceiver. Col. 3, line 63 - col. 4, line 3 describes that

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"the reduction of size makes it possible to reduce the restrictions on the place at which the mobile station is mounted in the vehicle. The mobile station may be located adjacent to the driver's seat, for example", suggesting that ~~that~~ the size of the satellite transceiver may even be small enough to be mounted near the driver. As to the argument that the "later added claims need not be limited to the specifics of the disclosed embodiments in order to satisfy the written description requirement under 35 U.S.C. 112", such a statement is true. However, the appellant is not allowed to present claims in which the original specification had no intention to possess. As argued above, there was no intention at the time the application was filed to include a mobile communication terminal equipment not connected to a vehicle. Therefore, the claims as presented are not supported by the specification.

Appellant argues with respect to the 103 rejection that the Japanese document '534 contains a switch for switching between the terrestrial and satellite system which is provided on the satellite side rather than on the terrestrial side as claimed. However, a suggestion within the reference teaches that separate transceivers, or mover, could be interchanged (page 7, line 30 - page 8, line 5 from the translation) thereby allowing increased flexibility. Therefore, such a suggestion would teach that circuitry such as the input/output circuit and switching means can be placed on the terrestrial side of the equipment.

Appellant also argues that one of ordinary skill in the art would not have attempted to modify the wireless satellite cellular telephone Wiedeman to make the terrestrial cellular telephone disconnectable from the satellite transceiver because the system is intended to be

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used as a roaming system for a terrestrial cellular user who travels into an area not served by any terrestrial system. On the contrary, the Wiedeman system is a telephone/satellite system, as described in the title, and would benefit from the teachings of the Japanese document since one of ordinary skill in the art would want to make the system of Wiedeman more convenient and portable in order to more easily access the terrestrial or satellite networks.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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PRIMARY EXAMINER

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October 23, 2000


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